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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/963,715

09/26/2001

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AUS920010319US1

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03/21/2007

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EXAMINER

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ART UNIT

PAPER NUMBER

3627

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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2 MONTHS

03/21/2007

PAPER

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GROUP 3600

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/963,715
Filing Date: September 26, 2001
Appellant(s): DUTTA ET AL.

Frank J. Campigotto
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1/19/06 appealing from the Office action mailed 5/11/05.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

The grounds of rejection to be reviewed in group (a) are limited only to the rejections directed to claims 1/16 and 2/17. No separate arguments is advanced for the other remaining claims.

The grounds of rejection to be reviewed in group (c) are limited only to the rejections directed to claims 11/12 and 25. No separate arguments is advanced for the other remaining claims.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,178,407	Blonder et al.	1-1998
6,178,407	Lotvin et al.	1-2001
6,052,675	Checchio	4-2000
6,674,368	Hawkins et al.	1-2004

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,2,4,5,13,16,17,19,20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blonder et al. in view of Lotvin et al.

Blonder et al. disclose a transaction authorization system in which upon a proposed purchase by a minor (col. 5 line 22) who is other than a card holder, an automatically created and electronically transmitted first message is generated (see col. 9, lines 11 et seq.) and transmitted to the parent of the minor (col. 5 lines 18-24). The method further is described as allowing parent approval prior to purchase by child (see col. 3, 32-42). The message describes the transaction in that as shown in Figs. 4 and 5, the description of the transaction is described in terms of when, how much, and who. The method of Blonder et al. further solicits the cardholder to enter a transaction authorization code to enable consummation of the proposed e-transaction (see col. 9 line 21). The pre-defined code then is sent back electronically as a reply message received by the validation means 106 to provide a transaction authorization code and e-transaction instructions (approval/disapproval message col. 9 line 19), and automatically executing the e-transaction instructions (step 705 validation automatically occurs). Also, Blonder et al. in col. 11, line 56-60. it is disclosed that E-instruction sent by the card owner, e.g. the parent, may take the form of an e-mail which is clearly an instructional communication about the transaction. But the method of Blonder et al. is silent as to whether the proposal by the child is one which is electronically transmitted.

However, Lotvin et al. disclose electronically receiving an e-transaction proposal from a minor (block 604 system receives the child's selection col. 13 line 54), which proposal has limitations placed on it by the parent, albeit in advance. It would be an obvious modification to the method of Blonder et al. to include an electronic proposal instead of the in person type disclosed in Blonder et al. because would this provide a more flexible method of purchasing and enhancing commerce by electronic means.

RE claim 2: the authorization from the transaction processing center to the retailer is read as the third message which is relayed by the retailer to the child in Blonder et al. The motivation set forth above is repeated herein.

RE claim 4: predefined is read as server verifiable. The motivation set forth above is repeated herein.

Re claim 5: since the reply is based upon the transactional information-specific information of the transaction as set forth in Figs 4 and 5, the predefined code of Blonder et al. is read as transaction specific. The motivation set forth above is repeated herein.

Re claim 13: the page message in Blonder et al. does set forth information on the goods (see Figs 4 and 5). The motivation set forth above is repeated herein.

Claims 1, 6-9, 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blonder et al. in view of Lotvin et al. and further in view of Hawkins et al.

The above combination fails to provide a teaching for notifying the parent via e-mail. However, Hawkins et al. disclose using either an email or paging as a form of notification. See, col. 12 lines 15-26. (see, col. 12 lines 12-31. It would be obvious to modify the notification system of Blonder et al. and hence Lotvin et al. to use e-mail instead of paging because Hawkins et al. do disclose either as equivalents, and the use of email when on line is more expeditious.

It is deemed obvious to use e-mail to notify the card owner of the prospective purchase as opposed to the paging system disclosed in Blonder et al. Hawkins et al. discloses using either an email or paging as a form of notification. See, col. 12 lines 15-26. Thus, an obvious modification to Blonder et al. would be to substitute an e-mail notification address for the parent's pager number notification discussed in Blonder et al. in col. 9, lines 11 et seq.

Claims 8, 9, 23, 24 recite the parent e-mail address being available from a database and the parent providing the e-mail address in advance of the e-transaction. The disclosure of such features is again found in Blonder et al. in the use of the a pre-populated database e.g. 106 (col. 5 lines 45-47), but in the context of pager numbers and not an e-mail address. As set forth above, the teaching of Hawkins et al. of using either email or paging as a form of notification (see, col. 12 lines 15-26) makes obvious the substitution of one for the other, especially given the growing use of emails over phone messaging.

Similarly, the recitation of the parent's e-mail address being provided by the minor in claim 7/21 is deemed met at least in part by Lotvin et al. in col. 5 lines 35-46 wherein the help desk is disclosed as responding to e-mails which system is disclosed as interfaced to the database to obtain up to date information on the users. Thus the use of a internet e-mail address is thus used to correlate a user to the name. The minor who uses his/her email will effectively be providing an identifier to the parent's control information which would include their address (see col. 13 lines 21-23). Since both Blonder et al and Lotvin et al. deal with monitoring the minor's use of purchasing the motivation to identify the parent through the internet address of the minor as taught by Lotvin et al. would be obvious.

Claims 1,10-12,14,25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blonder et al. Lotvin et al. and further in view of Miller.

The above combination fails to disclose a clickable option menu which allow the user to select options to selectively reject items of the transaction e.g. alert level sensitivity as shown in Fig. 12C. However, the secondary reference to Miller does teach listing of plural items via hyperlinks (clicking activates item) and causing selection therefor by clicking on one of the listed items. It would be obvious to use the clickable activation feature of Miller in Lotvin et al. to provide the parent with an item specific approval/disapproval method because this would allow for more specific detailed control by the parent. Moreover, it is the examiner's position that a list can be a list of one. Webster's Collegiate Tenth Edition merely defines, inter alia, "list" as "the total number to be considered or included". Blonder et al. clearly discloses in col. 13 lines, 10-19, lists each item by price of the proposed purchase. Subsequently, the parent in Blonder et al. this item is either accepted or rejected by the parent by either confirming the purchase or not (col. 13 lines 22-36). This confirmation or non-confirmation messaging is read as the instructions in claims 11/25 which are sent back to the retailer.

Claims 1,3, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blonder et al. in view of Lotvin et al. and further in view of Checchio. The above combination fails to disclose a reply

message having a credit card number for electronically funding. However, Checchio disclose control by a parent against use of credit card by family members col.6 lines 60-62 by using a code which releases the card number for purchase. It would be an obvious modification to this combination to include a message which releases the card number for purchase as taught by Checchio because this would expedite processing without need for verbal communication.

It is noted that while Blonder et al. disclose the sending of the credit card number in the responding confirmation message as opposed to having it send in the initiating message to the database 106, this is seen is a mere reversal of steps based on the known teaching of Checchio. Checchio does disclose the remote sending of a credit card number to a vendor to confirm a purchase. Both Blonder et al and Checchio deal with the remote order purchasing and securing authorization for such purchases. Checchio in col. 1 discloses sending the credit card number in a message to a vendor from a remote location via the telephone or computer:

(7) Furthermore, in many instances, the customer is not located within view of the vendor, as in the case of mail order purchases, telephone purchases and internet purchases. The conventional method for using a credit card in a mail order purchase, telephone order purchase or other remotely ordered purchase does not include a verification process to verify that the user of the credit card is authorized to make the purchase. Currently, vendors have no apparatus or method to verify that a user is an authorized user of a credit card when the purchase is being initiated at a location remote from the vendor, e.g., by mail, telephone, facsimile, or computer. As a result of the above-mentioned problems, credit card companies have incurred great costs in providing purchase credit to unauthorized users of credit cards.

Thus, Checchio teaches including a credit card as part of an order message sent to a remote vendor instructing confirmation of the purchase and to modify Blonder et al to use the credit card number in the reply would be a mere reversal of steps as made obvious by the know practice in Checchio.

(10) Response to Argument

a. 35 USC 103 Rejection of claims 1,2,4,5,13,16,17,19,20 based on Blonder et al in view of Lotvin et al.

It is the examiner's position that at the time of the invention, e.g. Appellant's filing date is 9/26/01, internet sales had become the new "retail environment" such that a modification to Blonder et al., to use the child electronic ordering system of Lotvin et al. would be obvious. The prior art reference to Blonder et al. discloses each and every step recited in claim 1 except for the electronically receiving of an e-transaction proposal from a minor. Instead, the method of Blonder et al. discloses the proposed purchase in a retailer environment.

Appellant asserts no e-transaction proposal exists in Lotvin et al. However, the primary reference to Blonder et al. discloses this feature. Even still, the definition of "proposal" is much broader than that on which Appellant relies.

Webster's Collegiate Dictionary Tenth Edition defines "proposal" as :

1. an act of putting forward or stating something for consideration;

Lotvin et al. col.13, lines 54-56, describes the system as receiving a minor's "selection". The term "selection" denotes the putting forth an item for consideration to the system which receives it. Likewise in Blonder et al., when the minor attempts to purchase an item, he/she puts forward his credit card for consideration by the merchant (col. 4, line 52,53). Moreover, this purchase proposal in Blonder et al. is made the subject of consideration by the parent who only after receiving the request, must approve the transaction before the credit card will be authorized. See, col. 5, lines 18 et seq.:

In the case where the cardholder is a minor, for example, by requesting approval of the transaction from a parent or guardian of the minor (i.e., the authorized party), the merchant and the debit card issuer are assured that the transaction cannot be voided by the minor at a later date on the ground that the minor lacked legal competency to enter into such transaction.

Appellant's only argument regarding Blonder et al. is that "Blonder et al. does not teach or suggest that the parent send additional instructions back with the authorization". (See, Brief, Page 8, line 14). But this is not an accurate assessment of Blonder et al. because in col. 11, lines 43-60, Blonder et al. disclose that instructions are sent by the card owner, e.g. the parent, to the retailer about the authorization terms. Furthermore, as disclosed in Fig 10 step 26, a two way pager is used to communicate with the retailer, see col. 13, lines 22-35. This communication which is disclosed as comprising an "appropriate confirmation" is read as being instructions which contain the code referenced in col. 9 lines 20,21. In other words, this reply message in Blonder et al. containing the code authorization is read as both, more generally, an instruction in the

form of a code instructing the retailer to process payment. That is, the authorization code forwarded to the retailer by the parent instructs by authorizing the retailer to allow the purchase.

Alternatively, the second embodiment in Blonder et al. discloses at col. 11 lines 55-60, circumstances where authorization may take up to a day, in which case authorization can take the form of e-mail. E-mail by definition is a message, e.g. an instruction directing communication. Within such a communication it is common knowledge to use e-mail as a way to communicate instructions. Moreover, the e-mail address is a code authenticating or instructing the retailer that the communication is from the user who the retailer thinks is generating the communication and which communication contains authorization. See, Blonder et al. col. 11, lines 43-60.

Finally, the language in claim 1 calls only for "providing e-transaction instructions" which can be read not as part of the receiving step in line 9 of claim 1 because the verb "receiving" is associated with the phrase "a reply message from the parent authorizing the e-transaction", and the verb "providing" is associated with the noun "instructions". Read in this way, Blonder et al discloses providing instruction in the form of e-mail (col. 11, 43-46) in one step, and in another step causes a reply message from the parent authorizing the e-transaction to be received by the retailer col. 13, lines 23-37. However read and interpreted, the language argued by Appellant is so much broader than that of

the scope of the arguments proposed by Appellant as to be clearly foreclosed by disclosure in Blonder et al.

Appellant argues in Blonder et al "the retailer cannot tell the minor 1. that the parents were contacted, or 2. that the parents did or did not approve the transaction" (Brief page 10). This argument makes no sense because the parent in Blonder et al. is notified by the pager number which he/she puts on file with the retailer and the code specific only to the parent must be sent to the retailer. To say there is no way to tell if the parents were contacted is simply incorrect because who else would be receiving a message on a dedicated pager line and return a code known only to the involved parent.

It is admitted that the limitation of electronically receiving an e-transaction proposal from a minor is not disclosed in Blonder et al. However, the secondary reference to Lotvin et al. does teach electronically receiving of an e-transaction proposal from a minor (block 604 system receives the child's selection col. 13 line 54). It is the examiner's position that at the time of the invention, e.g. Appellant's filing date is 9/26/01, internet sales had become the new "retail environment" such that a modification to the in person purchasing system of Blonder et al., e.g., to use the electronic ordering system of Lotvin et al., would be obvious. Clear motivation exists to combine. Both Blonder et al. and Lotvin et al are concerned with the problems associated with purchases made by minors. (see, Blonder et al. 5 lines 18 et seq.,

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Lotvin et al.-Abstract). To take what is otherwise done in person and to do it by computer, is deemed obvious because the motivation would be to follow the market place. That is, if the marketplace becomes electronically based, then should not the response to problems faced in this known marketplace be made in the same environment. It is well understood that the motivation need not be found in the references sought to be combined, but may be found in any number of sources, including common knowledge, the prior art as a whole, or the nature of the problem itself. DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co., 80 USPQ2d 1641, 464 F.3d 1356 (CAFC 2006) at 7, 8; *citing to*, *In re Dembiczak*, 175 F.3d 994, 999 [50 USPQ2d 1614] (Fed. Cir. 1999). As we explained in *Motorola, Inc. v. Interdigital Tech. Corp.*, 121 F.3d 1461, 1472 [43 USPQ2d 1481] (Fed. Cir. 1997), "there is no requirement that the prior art contain an express suggestion to combine known elements to achieve the claimed invention. Rather, the suggestion to combine may come from the prior art, as filtered through the knowledge of one skilled in the art."

In response claims 2/17 Appellant argues no showing in Blonder et al. of the feature of claims 2/17, but it is noted again that appellant's scope of argument exceeds that of the claims. Nowhere in claims 1/2, 16/17 is there any recitation of each message being sent from point A and arriving at point B. Rather, the claim recites open endedly, without any designated endpoint, the general step of receiving a reply and sending a third message which somehow notifies the minor of another condition. Nothing in the claim

language restricts the examiner from reading the processing center 106 as receiving the reply from the pager discussed in col. 9 and the subsequent transmission by the center 106 of the code 204 to the merchant which effectively notifies the miner that he/she has or has not been approved. (In examining a patent claim, the PTO must apply the broadest reasonable meaning to the claim language See, *In re Yamamoto*, 740 F.2d 1569, 1571, 222 USPQ 934, 936 (Fed. Cir. 1984)). Thus clear disclosure is found for this limitation in *Blonder et al.*

b. 35 USC 103(a) Rejection of claims 6-9, 21-24 based on *Blonder et al* in view of *Lotvin et al.* and *Hawkins et al.*

The issue involved with claims 6-9, 21-24 is one of obviousness in using e-mail to notify the card owner of the prospective purchase as opposed to the paging system disclosed in *Blonder et al.* *Hawkins et al.* disclose using either an email or paging as a form of notification. See, *Hawkins et al.*, col. 12 lines 15-26. Thus, an obvious modification to *Blonder et al.* would be to substitute an e-mail notification address for the parent's pager number notification discussed in *Blonder et al.* in col. 9, lines 11 et seq.

Claims 8 and 9 recite the parent e-mail address being available from a database and the parent providing the e-mail address in advance of the e-transaction. The disclosure of such features is again found in *Blonder et al.* in the use of the pre-populated

database e.g. 106 (col. 5 lines 45-47), but in the context of pager numbers and not an e-mail address. As set forth above, the teaching of Hawkins et al. of using either email or paging as a form of notification (see, col. 12 lines 15-26) makes obvious the substitution of one for the other, especially given the growing use of emails over phone messaging.

Similarly, the recitation of the parent's e-mail address being provided by the minor in claim 7 is deemed met at least in part by Lotvin et al. in col. 5 lines 35-46 wherein the help desk is disclosed as responding to e-mails and which system is disclosed as being interfaced to the database to obtain up to date information on the users. Thus, the use of an internet e-mail address is used to correlate a user to the IP address. In other words, the minor who uses his/her email will effectively be providing an identifier to the parent's control information which would include their address (see col. 13 lines 21-23). Since both Blonder et al and Lotvin et al. deal with monitoring the minor's use of purchasing the motivation to identify the parent through the internet address of the minor as taught by Lotvin et al. would be obvious.

c. 35 USC 103(a) Rejection of claims 1,10-12,14,25 based on Blonder et al in view of Lotvin et al. and Miller.

Appellant's only substantive argument regarding the claims in this group is directed to the subject matter of claims 11/24. The issue involved in claims 1,10-12,14,25 is the definition of "list". Appellant's argument would make the term include plural items, but it

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is the examiner's position that a list can be a list of one. Webster's Collegiate Tenth Edition defines, inter alia, "list" as "the total number to be considered or included". Blonder et al. clearly discloses in col. 13 lines, 10-19, lists each item by price of the proposed purchase. Subsequently, the parent in Blonder et al. this item is either accepted or rejected by the parent by either confirming the purchase or not (col. 13, lines 22-36). This confirmation or non-confirmation messaging is read as the instructions in claims 11/25 which are sent back to the retailer. Thus, Blonder et al. taken alone is sufficient to meet the limitations of claims 1,10-12,14,25.

However, alternatively, the secondary reference to Miller does teach listing of plural items via hyperlinks (clicking activates item) and causing selection thereof by clicking on one of the listed items. It would be obvious to use the clickable activation feature of Miller in Blonder et al because both deal with ordering an item, albeit Blonder et al. with products and Miller with computer services, and both address remote ordering of these items via a remote inter face 212 in Miller and a pager in Blonder. Therefore, the limitation of dependent claims 10-12, 14, and 25 cannot serve to patentably distinguish the claims from the prior art.

d. 35 USC 103(a) Rejection of claims 1,3,18 based on Blonder et al in view of Lotvin et al. and Checchio.

Appellant argues "Checchio does not disclose providing an e-transaction instruction in a responding message to charge goods or services to a particular credit card that is supplied in the message" (Brief pg.18). But again, the scope of these arguments vastly exceed that of the claims at issue. First, the issue of placing in the context of reply message some type of confirmation is a feature found in and provided by the base reference to Blonder et al., see col. 13 lines 22-37. The step of sending the credit card number in the responding confirmation message of Blonder et al., as opposed to having it sent in the initiating message to the database 106 of Blonder et al., is obviously modified by the teaching in Checchio. Checchio does disclose the remote sending of a credit card number to a vendor to confirm a purchase. Both Blonder et al and Checchio deal with the remote order purchasing and securing authorization for such purchases. Checchio in col. 1 discloses sending the credit card number in a message to a vendor from a remote location via the telephone or computer:

(7) Furthermore, in many instances, the customer is not located within view of the vendor, as in the case of mail order purchases, telephone purchases and internet purchases. The conventional method for using a credit card in a mail order purchase, telephone order purchase or other remotely ordered purchase does not include a verification process to verify that the user of the credit card is authorized to make the purchase. Currently, vendors have no apparatus or method to verify that a user is an authorized user of a credit card when the purchase is being initiated at a location remote from the vendor, e.g., by mail, telephone, facsimile, or computer. As a result of the above-mentioned problems, credit card companies have incurred

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great costs in providing purchase credit to unauthorized users of credit cards.

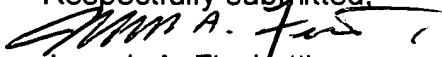
Thus, Checchio teaches including a credit card as part of an order message sent to a remote vendor instructing confirmation of the purchase and to modify Blonder et al to use the credit card number in the reply would be a mere reversal of steps as made obvious by the know practice in Checchio.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Joseph A. Fischetti

Conferees:

Alex Kalinowski 

Sam Sough 